charge, depending on what form the dye is in, what salt groups are present on the dyes, what solvent the dye is in, the pH of the solution of interest, etc. The reference is completely silent with respect to the particular charge states of the dyes to be used in any given procedure. The Examiner further indicated that he wished to review the case further to ensure that the case was in condition for allowance.

(2) On February 3, 2004, Applicant's undersigned attorney discussed the status of the subject application with the Examiner. As discussed, all rejections of record are withdrawn. The Examiner indicated, however, that USP 6,436,646 to Nikiforov contained disclosure corresponding to pending claim 1 of the subject application, at column 2. Applicants' undersigned attorney agreed to investigate inventorship of the relevant claim to determine whether an appropriate declaration could be provided to remove USP 6,436,646 as prior art to claim 1 of the subject application.

(3) On February 25, 2004, Applicants' undersigned attorney discussed the results of the inventorship investigation. As indicated, the '646 patent is not 102(e) prior art to claim 1, because claim 1 is the sole invention of Theo Nikiforov. The Examiner agreed that a declaration attesting to this would place the case in condition for allowance.

Applicants' attorney thanks the Examiner for the courteous, helpful and productive interviews.

REMARKS

The sole remaining issue in the case, as indicated in the interview summaries above, is that the Examiner has indicated that USP 6,436,646 has disclosure corresponding in scope to claim 1 of the subject application. Inventorship of the '646 patent overlaps with inventorship of the subject application, but is not identical. Specifically, the '646 patent is indicated to be the sole invention of Theo Nikiforov. Inventorship of the subject application is joint, i.e., Theo Nikiforov and Sang Jeong.

In the situation where listed inventorship between applications (or an application and a patent) is overlapping, but not identical, a rejection of a claim pursuant to 35 U.S.C. § 102(e) may appropriately initially be made, because the inventive entities between the relevant cases are not identical. However, such a rejection premised upon anticipation of a claim

pursuant to 35 USC § 102(e) can be overcome by presenting evidence that the relevant disclosure in the prior patent or application and the relevant claim, in fact, correspond to one another with respect to inventorship. That is, if it can be shown that disclosed, but unclaimed material in the prospective 35 § USC 102(e) reference is a disclosure of all of the claim's inventor(s), the reference does not actually qualify as 35 § USC 102(e) art, because the relevant prior patent/application is not "by another" as required by the relevant statute, with respect to the relevant claim. The MPEP provides that a declaration pursuant to 37 C.F.R. § 1.132 can be used for such a purpose. *See*, e.g., MPEP § 715.01 and starting at § 21364.04.

In the subject application, after appropriate investigation, it was determined that the claim at issue, i.e., claim 1, is the sole invention of Theo Nikiforov. Sang Jeong is listed as an inventor on the subject application for his contribution to certain dependent claims, e.g., those relating to performing FP in the absence of a polyion. Accordingly, inventorship of claim 1 of the subject application and of the relevant disclosure of material in USP 6,436,646 *are identical*. Thus, USP 6,436,646 is not prior art to claim 1 pursuant to 35 U.S.C. § 102(e), because it is not a disclosure "by another" as required by the statute. An appropriate declaration establishing inventorship pursuant to 37 C.F.R. § 1.132 is provided herewith.

It is also worth noting that Sang Jeong and Theo Nikiforov were both working under a common obligation of assignment at the time the invention was made, and the applications at issue are both currently assigned to Caliper Life Sciences Corporation. Accordingly, the provisions of 35 USC § 103(c) apply to the subject application. This means that USP 6,436,646 cannot serve as a basis for an obviousness rejection of any dependent claims of the subject application that have an inventive entity that differs from USP 6,436,646. Furthermore, a terminal disclaimer with respect to USP 6,436,646 has already been filed. Accordingly, no obviousness-type double patenting rejection can be applied between USP 6,436,646 and the subject application.

To avoid any possible confusion with respect to the assignment issue noted above, Applicants note for the record that Caliper Technologies Corp. recently changed its name to Caliper Life Sciences Inc.; this was a change in corporate name only. All assignments to Caliper Technologies Corp. are now held by the renamed Caliper Life Sciences Inc.

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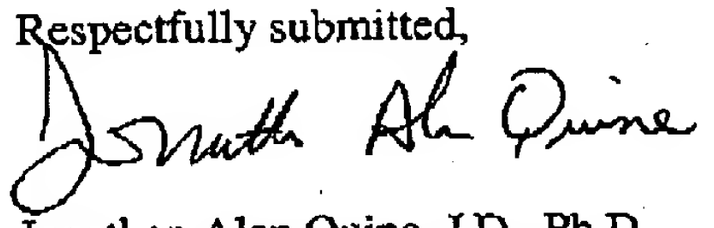
Respectfully submitted,



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